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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,383	08/26/2003	Kotaro Kaneko	1011350-000320	2047

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EXAMINER	
SHAN, APRIL YING	

ART UNIT	PAPER NUMBER
2435	

NOTIFICATION DATE	DELIVERY MODE
07/14/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/647,383	KANEKO, KOTARO	
	Examiner	Art Unit	
	APRIL Y. SHAN	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,11-14,19 and 24-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,11-14,19 and 24-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *8/26/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on 12 April 2010, PROSECUTION IS HEREBY REOPENED. After careful search, new grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

2. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

3. Claims 1-4, 11-14, 19 and 24-26 are pending in the application. Claims 5-10, 15-18 and 20-23 are canceled. Thus, claims 1-4, 11-14, 19 and 24-26 have been examined.

Response to Argument

4. The Applicant's remark/argument regarding Togawa (U.S. Patent No. 5,918,008) in the Appeal brief is summarized as below:

a. The Applicant argues: "Togawa does not disclose or suggest that a file which is not included in the original information management file is judged to be a file having been infected with a virus", the examiner found this argument persuasive. In the

below new grounds of rejections Geiger in view of Radatti and further in view of Motoyama et al., this limitation is addressed. Especially, Geiger (WO 00/72149 A1) teaches in SIM 15 is a list 33 of authorized applications – e.g. lines 2-3, page 4, for running of an application, a check is made against the list 33 in the SIM 15 to verify whether the application is authorized for running – lines 10-12, page 4, if no list entry for the object is present – e.g. line 10, page 6 and if no list entry for the object is present, full signature verification is performed. If the digital signature is not verified (e.g. lines 10-12 and lines 18-19, page 6), then it is an unauthorized or illegal program. Once a comparison cycle is run, any anomalous file may be **automatically** deleted - e.g. par. [0068] of Radatti.

b. The Applicant argues dependent claims are allowable due to dependency, the examiner respectfully disagrees and these arguments are addressed in the below new ground of rejections.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per **claim 1** and **dependent claims 2-4**, they recite a computer program stored on a computer readable recording medium. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. In light of Applicant's own disclosure (Please see par. [0091]), "a computer readable recording medium

such as a flexible disk and CD-ROM". The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The Applicant does not explicitly define such computer readable recording medium excluding signals. Please note to an ordinary skill in the art that the "a computer readable recording medium" without any definition in the specification would be reasonable to interpret the term as encompassing signals. Note that as per In re Nuijten, 500 F.3d 1346, 1357 (Fed. Cir. 2007), signals are not statutory. As such, claims 1-4 recite non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-3, 11-13, 19 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger (WO 00/72149 A1) in view of Radatti (U.S. Pub. No. 20030140049) and further in view of Motoyama et al. (U.S. Patent No. 7,743,133).

As per **claims 1, 11 and 19**, Geiger discloses a computer program/method/apparatus for controlling apparatus executing the procedures of:

storing a preset list of programs that are authorized to be run on said controlling apparatus (microprocessor 12 – e.g. line 10, page 4) to control computer systems (Illustrated in SIM 15 is a list 33 of authorized applications – e.g. lines 2-3, page 4);

confirming each program running on said controlling apparatus (In operation, the mobile communication device is powered up and applications are loaded from the program memory into the microprocessor – e.g. lines 8-10, page 4);

judging a program, which is not included in the preset list of programs that are authorized to be run to control the computer systems among programs whose running states have been confirmed, (for running of an application, a check is made against the list 33 in the SIM 15 to verify whether the application is authorized for running – lines 10-12, page 4, if no list entry for the object is present – e.g. line 10, page 6);

Although Geiger discloses if no list entry for the object is present, full signature verification is performed. If the digital signature is not verified, the application is not launched (e.g. lines 10-12 and lines 18-19, page 6). Once the signature is not verified, the program is considered as an unauthorized or illegal program and the application is not launched (e.g. lines 10-12 and lines 18-19, page 6), Geiger does not explicitly disclose the application as an illegal resulting from a computer virus infection and deleting or isolating the program that is judged to be illegal program. Radatti, however, met the claimed limitation by teaching to discover anomalous files, e.g., viruses, Trojan Horses, etc and they were not been present in the initial secure system data file – e.g. par.

[0045] and once a comparison cycle is run, any anomalous files may be automatically deleted - e.g. par. [0068] of Radatti).

Geiger – Radatti are analogous art because they are from a similar field of endeavor in monitoring mechanism. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the teachings of Geiger with the application as an illegal resulting from a computer virus infection and deleting or isolating the program that is judged to be illegal program taught by Radatti. The motivation of doing so would have been for securing, maintaining, monitoring and controlling computer systems (e.g. par. [0001] of Radatti).

Geiger – Radatti does not explicitly disclose monitoring programs running on an image forming apparatus. However, Motoyama et al. met the claimed limitation by disclosing monitoring a software program running on an image forming apparatus (e.g. abstract).

Geiger – Radatti – Motoyama et al. are analogous art because they are from a similar field of endeavor in monitoring mechanism. Thus, it would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the teachings of Geiger - Radatti with monitoring a software program running on an image forming apparatus taught by Motoyama et al. in order to evaluating how a user utilizes a software application running on an image forming apparatus (e.g. col. 2, lines 15-19).

As per **claims 2, 12 and 24**, Radatti further discloses executes a procedure of automatically deleting or isolating the file that is judged as illegal file (once a comparison cycle is run, any anomalous files may be automatically deleted - e.g. par. [0068]).

As per **claims 3, 13 and 25**, Radatti further discloses wherein the procedure of judging includes a procedure of comparing the name of each file whose existence has been confirmed with the name of each file included in said list (compare file names - e.g. par. [0015]).

10. Claims 4, 14 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger (WO 00/72149 A1) in view of Radatti (U.S. Pub. No. 20030140049) and in view of Motoyama et al. (U.S. Patent No. 7,743,133).and further in view of Cozza (U.S. Patent No. 5,649,095).

As per **claims 4, 14 and 26**, Although Radatti discloses judging includes a procedure of comparing the name of each file whose existence has been confirmed with the name of each file included in said list (compare file names - e.g. par. [0015]), Geiger – Radatti – Motoyama et al. does not explicitly disclose comparing the size of each file whose existence has been confirmed with the size of each file included in said list. However, Cozza met the claimed limitation by teaching scanning files for computer viruses which use the length of at least one portion (such as a fork) of a file. This length information is stored in a cache. During a scan, the then current size of the file portion is compared to the length stored in the cache and if there is a size difference, the file is then scanned for virus which can change that portion of the file's size (e.g. abstract and col. 3, line 62 - col. 4, line 17 of Cozza).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Cozza's comparing the size of each file whose existence has been confirmed with the size of each file included in said list into Geiger – Radatti – Motoyama et al.. The motivation of so would have been to guarantee a great scanning speed increase by

eliminating uncessary, repeat scanning in return for a very modest cost (e.g. col. 4, lines 13-16 of Cozza).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435